

REMARKS

Claims 2-13 and 15-20 have been amended to correct formal problems noted by the Examiner. Applicants respectfully submit that these changes are purely pedantic in nature, do not affect the scope of the claims, and therefore should not give rise to any filewrapper estoppel.

Applicants further respectfully submit that these changes could not have been made earlier as they were only required in the latest office action, and are not necessary for definiteness; and moreover that they will require no further consideration by the Examiner. Entry is therefore respectfully requested.

Art rejections

The art rejections are respectfully traversed.

Since the references are many and complex, Applicants will confine their remarks to those portions of the reference cited by the Examiner, except as otherwise indicated. Applicants make no representation as to the contents of other portions of the references.

Any of the Examiner's rejections and/or points of argument that are not addressed below would appear to be moot in view of the following. Nevertheless, Applicants reserve the right to respond to those rejections and arguments and to advance additional arguments at a later date. No arguments are waived and none of the Examiner's statements are conceded.

General comments with respect to Bornhorst

The Examiner groups the embodiments of figures 8-12 of Bornhorst together, without apparently recognizing that these are distinct and incompatible embodiments. Applicants

REMARKS

accordingly respectfully submit that the rejections are indefinite and confusing and fail to satisfy 37 CFR 1.104.

What does “rotation member” mean as used in this application? (claims 1 and 14)

Claim 1 recites a first rotation member which is rotatable with respect to the foot. It is instructional to look at how the term “rotation member” is used in the specification. The term “rotation member” is defined in context with respect to the prior art in the background section. The “rotation member” is the specific structure that is causing the rotation with respect to the particular axis, not other structures that might be attached to the rotation member and also rotating about the particular axis as a result of being connected to the rotation member. Thus if the first member is rotatable with respect to a first axis and a second rotation member is rotatable about a second axis, the second rotation member may also be rotating with respect to the first axis – but the second rotation member is not specifically the rotation member that is rotatable with respect to the first axis – as those terms are used in the specification. The terminology is used in this specific way to distinguish over prior art devices, where the rotation member, i.e. the member causing the rotation, is not the one holding the light source -- so one of ordinary skill in the art understands what is meant.

The Examiner cites Bornhorst’s element 82 as the recited rotation member. In Fig. 8, element 82 does not appear to be rotatable at all.

The Examiner then cites Bornhorst’s Fig 12 – but it is not clear how Fig 12 is supposed to be combined with Fig. 8, since they are distinct embodiments. Fig. 12 has an element 82, but to

REMARKS

the extent that element 82 may be a rotation member¹ in Fig. 12, it would be rotatable with respect to an axis displaced from the foot. The rotation member that is rotatable with respect to the foot in Fig. 12 is element 86 -- but element 86 does not contain the light source. Element 82 is the member that contains the light source. This is precisely what is distinguished in the background section where terminology is explained with the intent of distinguishing over such structures. The specification is the primary source for definition of terminology. Therefore Bornhorst fails to teach or suggest the claimed invention

Claim 14 is analogous to claim 1 in this respect.

Applicants accordingly respectfully submit that the Examiner has failed to make a *prima facie* case against claims 1 and 14.

Claims 3 (&16) and 5 (&17)

The validity of the rejection of these claims seems to depend on whether the pan tube 40 is considered part of the first rotation member or part of the second rotation member. It would appear from Bornhorst's col. 4, lines 7-15 that the pan tube is actually part of the second rotation member, since it is the means by which element 26 rotates. Accordingly, it appears to be inaccurate to say that the second rotation member encompasses the first rotation member per claim 3, since the pan tube is inserted inside the housing of element 82.

¹ Applicants do not concede that this is the case, as it is not clear to them. The rotation may be coming entirely from elements 86, 84, and 16.

REMARKS

Alternatively, if the Examiner thinks that tube 40 is part of the first rotation member, then 40 is not an internal outlet for light, as proposed by the Examiner in rejecting claim 5, but rather an external outlet protruding from member 82.

In either case, the two rejections cannot be maintained together as they are mutually contradictory.

Applicants accordingly respectfully submit that the Examiner has failed to make a *prima facie* case against either claims 3/16 or claim 5/17 or both.

Claim 6

The prior remarks about claim 6 are incorporated by reference and supplemented as follows.

The Examiner says that element 40 in Bornhorst is a disk. Applicants respectfully disagree. The reference characterizes it as a pan tube. It has to be a hollow tube, for light to go through it. A tube is not a disk. Indeed the tube appears from the drawing to extend well below the pulley arrangements 72 & 75 in an elongated shape; see also col. 9, lines 49-55 indicating that the lens assembly 89 b, c & d is also in the pan tube. This means that it is an elongated tube, not a disk.

Applicants accordingly respectfully submit that the Examiner has not made a *prima facie* against claim 6.

Claim 21

The claim recites a rotation mechanism at the exterior of the housing. This mechanism is explicitly recited as one of the bullet items within the first rotation member, i.e. part of the first

REMARKS

rotation member which also contains the light source. The preposition “at” here signifies that the mechanism is not external to the rotation member, but at the exterior. Reference should be made again to the way “rotation member” is defined in the background section of the invention.

The Examiner again refers to the alleged rotation member 82. The Examiner refers first to Fig. 8, where member 82 does not rotate. The Examiner also refers to element 86 in Fig. 12, where the rotation mechanism about the foot 46/88 occurs at element 86, not **at** an exterior of and as part of element 82, which contains the light source, as recited in the claim.

Applicants accordingly respectfully submit that the Examiner has not made a *prima facie* case against claim 21.

Claim 26

This claim recites that the first housing is adapted to be suspended from the foot.

The Examiner purports to find this in Fig. 12 of Bornhorst. Applicants respectfully disagree. The housing of element 82 is not adapted to be suspended from the foot 46/88 in that figure. Instead, an additional element 86 is the one that is suspended and element 82 is suspended from element 86. Again, the reference should be made to the way “rotation member” is defined with respect to the prior art in the background section of the invention.

Applicants accordingly respectfully submit that the Examiner has not made a *prima facie* case against this claim.

Bornhorst/Headrick combination/ bearing means (claims 4, 16)

Applicants respectfully reiterate that the combination of these two references is not possible. They are two completely different apparatuses with totally different and incompatible

REMARKS

structures. Headrick has plural light sources and a complicated system of gears that interact with each other. Bornhorst has a much simpler arrangement of pan and tilt tubes with one light source. There could be no motivation to combine them by one of ordinary skill in the art, because it would not be clear what to combine or how to put that combination together. Any hypothetical combination would be a knee bone connected to shoulder bone type dysfunction – and would not be the bearing means of claims 4 & 16. Applicants accordingly respectfully submit that any hypothetical working combination of the two references that might have any resemblance to the claimed invention could only be arrived at through impermissible hindsight in light of Applicants claims and specification.

Claim 27

This claim recites that the light source defines a beam direction that is substantially horizontal.

The Examiner purports to find this in Bornhorst. Applicants respectfully disagree. They see no figure indicating that member 82 can assume a horizontal position. Fig. 12 only shows it in a tilted position. Since panning is supposed to come from pan tube 40 and tilting is supposed to come from tilt tube 20 in Bornhorst, Applicants see no reason to suppose that there is any need for the member 82 to be horizontal.

The claim further recites that the upper part of the reflector is always cooled.

The Examiner purports to find this in Headrick. Applicants respectfully disagree. Applicants see, in Fig. 5 of Headrick, cooling air coming from inlet 94, through the base of the reflector at 86, around the lamp 76, and into the tube 88. Since this reflector is horizontal, defining a vertical light beam, the upper parts of the reflector are the upper edges distant from the

REMARKS

lamp 76. Applicants do not see this portion of the reflector being cooled by the air flow, particularly.

Applicants accordingly respectfully submit that the Examiner has failed to make a *prima facie* case against this claim.

Claim 22: Bornhorst/Pujol

Claim 22 recites that the first housing forms a concavity and a portion of the second housing is movable within that concavity.

The Examiner sees this in element 82 of Bornhorst, but Applicants do not. Applicants see the housing of element 82 as being entirely convex.

The Examiner then cites Pujol. Applicants are finding this rejection especially confusing. The Examiner cites Fig. 12 of Pujol, but then points to columns 6 and 8 of Pujol. Columns 6 and 8 of Pujol describe figures 1-3, not Figure 12. Applicants find, per column 6, that Pujol has a fixed housing 12 and a rotating housing 14. Applicants do not see that the first housing is forming any concavity. Applicants do not see that any portion of the housing 14 is rotating within the housing 12, either. They seem to be entirely separate. Fig. 12 seems to be directed to optical components within the housings. Applicants fail to understand how Pujol relates to the rejected claim at all.

Applicants accordingly respectfully submit that this rejection fails to comply with 37 CFR 1.104.

REMARKS

Claim 23 (Bornhorst/DE3807504)

This claim stands rejected over a German language reference. The assignee has informed the undersigned that applicants have not received any translation of this reference. The undersigned is accordingly unable to discern the truth or falsity of what the Examiner has stated about this reference. Applicants respectfully submit that the rejection is in violation of MPEP 706.02.

However, Applicants think they understand from an English language abstract downloaded from the Internet at the esp@cenet database², that the light source 10 is in a housing 20 – and that the rotation members are actually not at the exterior of that housing, but rather on separate members 14, 16, 18. Applicants therefore suspect that this reference does not say what the Examiner thinks it says.

Claim 24 (Bornhorst/Pujol/DE 3807504)

This claim recites the first and second housings each forming concavities and each having a portion movable within the concavity of the other. Applicants would particularly like the Examiner to look at the several figures, which illustrate an ingenious configuration that makes this recitation possible.

² Abstract of **DE3807504**

A description is given of an illumination device (10) having at least one electrical light source which is arranged in a mount (holder) (20) provided therefor. The mount (20) is provided in a holding device (12). The holding device (12) has at least one frame-shaped element (14) or two, three, or more than three frame-shaped elements (14, 16, 18). The frame-shaped elements can be swivelled about two connecting axes (32, 38) which can be arranged so as to be at least approximately perpendicular to each other. In this way the lamp mount (20) and thus an electric light source arranged in the mount (20) can be adjusted to any desired solid angle.

REMARKS

Applicants have previously commented on the deficiencies of these references taken separately. Applicants conclude that taken as a whole there is no teaching or suggestion that of the first and second housings would each have a concavity and that each would have a portion movable within the concavity of the other. Applicants find the references similarly deficient in this respect. Applicants also respectfully submit that the Examiner is engaging in impermissible hindsight in light of Applicants' disclosure.

Claim 25

This claim recites that the housing of the first rotation member rests on top of the foot.

The Examiner reiterates the rejection of claim 26, which has been previously discussed as deficient – and then purports to find the recitations of claim 25 obvious. Applicants respectfully submit that claim 25 is even more clearly patentable over the reference than the prior claims, and that no reference cited by the Examiner shows the housing containing the light source resting on the foot at all. Applicants respectfully request the Examiner to come up with a reference that actually shows this recitation.

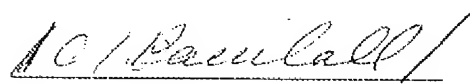
Please charge any fees other than the issue fee to deposit account 14-1270. Please credit any overpayments to the same account.

REMARKS

Applicants respectfully submit that they have addressed each issue raised by the Examiner — except for any that were skipped as moot — and that the application is accordingly in condition for allowance. Allowance is therefore respectfully requested.

Respectfully submitted,

By



Anne E. Barschall, Reg. No. 31,089

Tel. no. 914-332-1019

Fax no. 914-332-7719

Date of printing: September 5, 2007

In house contact at assignee:

Frank Keegan

Reg. No. 50,145

Tel. # 914-333-9669